

Appl. No. 10/078,043
Any. Docket No. 8431M
Amdt. dated March 30, 2004
Reply to Office Action of December 30, 2003
Customer No. 27752

REMARKS

Claims 1-13 are pending in the present application. No additional claims fee is believed to be due.

Claim 8 has been amended to correct a typographical mistake regarding the term "form". It has been replaced in accordance with the Office Action with the term "from".

Claim 14 has been canceled without prejudice in accordance with the Office Action. Claims 15-20 have been canceled without prejudice.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 102 Over Eckhouse

Claim 1:

The Office Action has rejected claims 1-20 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 5,720,772 issued to Eckhouse. The previous response filed December 1, 2003 asserted that the Eckhouse reference did not teach an apparatus that "is adapted for placement proximate to the *in-vivo* location of said pathogen, wherein said *in-vivo* location of said pathogen is a plant or parts thereof" as recited, in part, by claim 1. In response the present Office Action states that "the added limitation is merely directed towards the intended use of the device and is no way a structural limitation." (See Office Action pages 4-5).

It has been held that a functional limitation in a claim "must be evaluated and considered... for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." (MPEP §2173.05(g)). Claims containing language such as "members adapted to be positioned" provide structural attributes to a claimed assembly. (See MPEP § 2173.05(g) citing *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)).

Applicants assert that the limitation of claim 1 does in fact add structural limitations to the claim in that the apparatus is "**adapted** for placement proximate to the *in-vivo* location of said pathogen, wherein said *in-vivo* location of said pathogen is a plant or parts thereof." (See claim 1)(emphasis added). Because the apparatus is adapted for placement *in-vivo* of a plant or proximate thereto, there are structural attributes provided to the apparatus that one skilled in the art would recognize. Therefore, the recitation of this limitation within claim 1 does add structure to the claimed invention.

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Because the Office Action treated the limitation of claim 1, i.e. the functional recitation, non-structural in nature, the Office Action found no missing elements in the Eckhouse reference. (See Office Action page 5). The Office Action states that "there is no element missing from the Eckhouse reference as the Eckhouse reference teaches every structural element and is simply silent with respect to the use of the device to treat a plant." However, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully traverse the rejection by the Office Action because the cited reference fails to teach all of the elements of the claimed invention.

As the Office Action provides, the Eckhouse reference is silent with respect to the use of the device to treat a plant. Thus, as previously asserted, the Eckhouse reference fails to teach all of the claim elements of claim 1. Because the Eckhouse reference fails to teach all of the claim limitations of claim 1, the Eckhouse reference is precluded from anticipating claim 1. So, Applicants assert that claim 1 is in condition for allowance. Also, because claim 2 depends from claim 1, Applicants assert that claim 2 is also not anticipated by the Eckhouse reference and is therefore in condition for allowance.

Claim 11:

The Eckhouse reference fails to teach all of the claim elements of the invention of claim 11. However, the Office Action asserts that a claimed element which is not taught in the Eckhouse reference is inherently performed by the device taught in that reference. The Office Action states:

[C]laim 11 recites a device that is "adapted for placement proximate to said tympanic membrane of said animal". Again, this recitation defines no particular structure and is only suggestive of how the device may be used. The examiner maintains that while the Eckhouse reference is silent regarding the treatment of the tympanic membrane of a subject, the device is inherently capable of being located in proximity to the tympanic membrane and therefore meets the structural limitations of the claims....

Claim 11, as discussed above, merely requires the device to be capable of being located in proximity to a tympanic membrane. The Eckhouse device is clearly "adapted" to be located in proximity to a tympanic membrane. The method steps of claim 11 do not recite that the device is actually located near or used to treat a tympanic membrane.

(Office Action page 5).

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Based on the caselaw cited previously, Applicants assert that the above mentioned limitation of claim 11 does in fact add structural limitations to the claim in that the apparatus is "adapted for placement proximate to said tympanic membrane of said animal." (See claim 11)(emphasis added). Because the apparatus is adapted for placement proximate to said tympanic membrane, there are structural attributes provided to the apparatus that one skilled in the art would recognize.

As the MPEP states, functional limitations must be evaluated in the context in which they are used. Claim 11 does not expressly provide for the treatment of the tympanic membrane, it does expressly provide for the treatment of "acute otitis media." When taken in context with other elements of the claim, acute otitis media corresponds to an inner ear infection "in a mammal, such as a dog, cat or human." (Specification page 21, lines 7-18). The specification also provides that in a preferred embodiment, an apparatus can provide sufficient electromagnetic radiation having such an intensity that meaningful suppression in acute otitis media is achieved while minimizing erythema on the tympanic membrane of the animal. (See *Id.*). Thus, the limitation of "adapted for placement proximate to said tympanic membrane," in context, implies with it the treatment of an inner ear infection. Therefore, the recitation of this functional limitation in claim 11 does add structure to the claimed invention.

Regarding inherency, a gap in a cited reference may be filled by extrinsic evidence, but such evidence must be necessarily present in the thing described in the reference. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). However, inherency may not be established on mere probabilities or possibilities. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Simply because "a certain thing may result from a given set of circumstances", is not sufficient to establish inherency. See *Id.*

As mentioned above, the Office Action states, "while the Eckhouse reference is silent regarding the treatment of the tympanic membrane of a subject, the device is inherently capable of being located in proximity to the tympanic membrane." (See Office Action page 5). Again, the Eckhouse reference teaches the treatment of skin disorders primarily or the use of a flashlamp in invasive procedures such as lithotripsy or the removal of blood vessel blockage. (col. 8, lines 56-60). The Eckhouse reference offers evidence of treating skin ailments but offers none with respect to the treatment of inner ear infections or that their treatment is necessarily derived from the apparatus. Therefore, the Eckhouse reference fails expressly or inherently teach all of the claim elements of the claimed invention.

Because the Eckhouse reference does not teach all of the claim elements of claim 11, Applicants assert that claim 11 is not anticipated by the Eckhouse reference and therefore, is in

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condition for allowance. In addition, because claims 12 and 13 depend from claim 11, Applicants assert that they too are not anticipated by the Eckhouse reference and are also in condition for allowance.

Claim 15:

Claim 15 has been canceled as well as all claims depending therefrom.

Rejection Under 35 USC 103(a) Over Eckhouse in view of Talmore

Claims 10 and 15-20 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 5,720,772 issued to Eckhouse in view of U.S. Pat. No. 5,344,433 issued to Talmore. Applicants respectfully traverse the rejection by the Office Action because the Office Action has failed to establish a *prima facie* case of obviousness. The Applicants will only address the issue of obviousness with respect to claim 10 because claims 15-20 have been canceled.

In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* The Office Action fails to establish a *prima facie* case of obviousness because the combination of references fails to teach or suggest all of the claim limitations of the claimed invention.

The Office Action asserts that the Talmore reference teaches "a light treatment device for the treatment of psoriasis, similar to the Eckhouse skin treatment device. In particular, Talmore teaches the use of flashlamps to treat psoriasis, as well as additional skin conditions such as skin fungus as disclosed in column 4, lines 62-68 of the Talmore patent."

While the Talmore reference may teach some of the claim limitations that the Eckhouse reference is lacking, i.e. the treatment of pathogens and fungi, the Talmore reference fails to teach or suggest the claim elements which distinguish the claimed invention over the Eckhouse reference. Namely, the Talmore reference fails to teach or suggest that the apparatus is "adapted for placement proximate to said tympanic membrane of said animal," as recited, in part, in claim 11. Because claim 10 depends from claim 11, the cited combination fails to teach or suggest all of the claim limitations of the invention of claim 10.

Because the cited combination fails to teach or suggest all of the claim limitations of the invention of claim 10, the Office Action fails to establish a *prima facie* case of obviousness. Therefore, Applicants assert that claim 10 is nonobvious over the cited combination.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(b) and § 103 (a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-13.

Respectfully submitted,

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March 30, 2004
Customer No. 27752
(Amendment-Response to Office Action.doc)
Revised 10/14/2003